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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,619	10/28/2003	Howard Elliott	85328.88008	3907
22807	7590	06/26/2006	EXAMINER	
GREENSFELDER HEMKER & GALE PC SUITE 2000 10 SOUTH BROADWAY ST LOUIS, MO 63102			PICKETT, JOHN G	
		ART UNIT	PAPER NUMBER	3728

DATE MAILED: 06/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/695,619	ELLIOTT, HOWARD	
	Examiner	Art Unit	
	Gregory Pickett	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 April 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-9, 11 and 12 is/are rejected.
- 7) Claim(s) 10 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 28 October 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action acknowledges the applicant's amendment filed 12 April 2006.

Claims 1-12 are pending in the application. Claims 1-8 and 10-12 remain in their original state; claim 9 was previously amended.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Margulies et al [US 4,294,361; hereinafter Margulies; provided by applicant] in view of Price [US 5,339,960; previously provided].

Claim 1: Margulies discloses a container [Figure 1] comprising a tray **10** with a planar top surface and a plurality of cavities **12**, and a cover film **14** having pre-formed tear lines **20 & 26** defining a tear-off portion with an associated lug **22**. Tray **10** has an upwardly extending protrusion **18** to bend lug **22** upwardly out of the plane of cover film **14** [see Figure 3]. Margulies merely lacks the express disclosure of the pre-formed tear lines corresponding to the periphery of the cavities.

Price discloses pre-formed tear lines **18** corresponding to the periphery of cavities **12** for controlled tearing of the cover. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the tear lines **26** of

Margulies in a shape corresponding to the periphery of the cavities as taught by Price, in order to control the tearing of the cover film.

4. Claims 2-8, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Margulies-Price as applied to claim 1 above, and further in view of Braverman [US 3,924,748; previously provided].

Claims 2 and 4: Margulies-Price discloses the claimed invention except that Margulies-Price uses a heat seal instead of a peelable adhesive. Braverman shows that a peelable adhesive **50** was an equivalent structure known in the art. Therefore, because these two sealing means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the peelable adhesive of Braverman for the heat seal of Margulies-Price. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

Claim 3: Margulies discloses an array as claimed.

Claim 5: Margulies-Price-Braverman, as applied to claim 4 above, discloses the claimed invention except for the patches. Braverman discloses patches **52** used to prevent the retained articles from adhering to the cover film. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the film of Margulies-Price-Braverman with patches in order to prevent the retained

articles from adhering to the cover film. Such patches would have the claimed vapour barrier properties.

Claim 6: It would have been obvious to one of ordinary skill in the art at the time the invention was made to extend the patch of claim 5 into the lug in order to prevent the lug from adhering to protrusion 18.

Claims 7 and 8 are product-by-process claims. Claims 1-6 claim the container in assembled form. The claiming of a barrier film amounts to the claiming of the means by which the cover film and patches are formed prior to assembly. The method of forming the device is not germane to the issue patentability of the device itself. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Even so, Braverman discloses a barrier film 44 with preformed tear lines 54 & 56, which function as claimed.

Claims 11 and 12: Braverman discloses a paper film [Col. 4, lines 23-27] that is non-rupturable within the meaning disclosed by the applicant. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the cover film of paper in order to enable printing on the cover film. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Margulies-Price-Braverman as applied to claim 8 above, and further in view of March [US 3,880,285; previously provided].

Margulies-Price-Braverman discloses the claimed invention except for the projections on the tray and apertures on the cover film.

March discloses projections **47** on a tray **41** cooperatively received by apertures **49** on cover film **16** for rapid assembly of the device [Col. 4, line 64 to Col. 5, line 2]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the container of Margulies-Price-Braverman with projections and apertures as taught by March in order to facilitate rapid assembly of the device.

Allowable Subject Matter

6. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response to Arguments

7. Applicant's arguments with respect to claims 1-12 have been fully considered but are not persuasive.

8. Applicant's arguments against the embodiment of Figures 4-6 of Margulies are irrelevant since it is the embodiment of Figures 1-3 that is used in the rejection. Since such arguments are not on point, they are not persuasive.

9. Applicant's argument that lug is not secured to the tray is not persuasive and appears to bolster the examiner's position since claim 1 clearly presents that the lug is not secured to the tray (lines 13 and 14 of the claim).

10. Applicant's argument that the projection and lug of Margulies is not upwardly extending when the cover film is secured to the tray is immaterial since Margulies clearly shows an upwardly extending projection and lug in Figure 3. The fact that a user of Margulies must perform an act prior to the device having a particular arrangement does not detract from the fact that the claimed arrangement is disclosed. Applicant has presented an article claim, which describes an article as it exists in a point in time. In Figure 3 of Margulies, lug **22** is bent out of the plane of the remainder of the cover film **14** when the cover film is secured to the tray **10**. The fact that Margulies discloses additional structure not claimed is irrelevant.

11. In response to applicant's argument that Price contains additional, complicated structures and features, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or

all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

12. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion can be found in Price (see for example, Col. 3, lines 15-18).

13. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Art Unit: 3728

14. All benefits of claimed invention need not be explicitly disclosed in reference to render claim unpatentable under 35 USC 103. See *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990). Since the claimed subject matter would have been obvious from the references, it is immaterial that the references do not state the problem or advantage ascribed by applicant. See *In re Wiseman*, 201 USPQ 658.

15. In order to rely on equivalence as a rationale supporting an obviousness-type rejection, the equivalency must be recognized in the prior art. *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958). Braverman represents evidence that a peelable adhesive was art-recognized equivalent structures for a seal. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

16. As to the applicant's arguments concerning the vapor barrier properties, these properties are inherent in the materials used in the patches of Braverman. Moreover, virtually any additional structures placed in a layered format on the cover film would reduce the vapor transmission properties by mere physical interference.

17. The determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re*

Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. (Same cite as above)

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gdp
Greg Pickett
Examiner
18 January 2006

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